

REMARKS/ARGUMENTS

Claims 15-16 and 23 are cancelled; no new matter is added.

The obviousness rejection of Claims 1, 4, 7-14, 17-20, and 24-25 as being unpatentable in view of Katsuma and Osborne is traversed because the Office has filed to consider Katsuma as a whole; because there is no motivation to combine the references; because Katsuma “teaches away from” at least one feature of present Claim 1 and the claims depending therefrom; and because the Office’s combination of the references impermissibly renders Katsuma inoperable for its intended purpose.

Present Claim 1 is drawn to an external preparation that is a poultice or plaster. The external preparation comprises (A) pitavastatin, atorvastatin, a salt of pitavastatin, or a salt of atorvastatin, and (B) at least one monoterpene selected from the group consisting of menthol, terpineol, citronellal, and combinations thereof. The external preparation does not contain ethanol.

M.P.E.P. § 2141.02(VI) describes, in part that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” Applicants submit that the Office, in making the obviousness rejection, has failed to consider Katsuma as a whole.

M.P.E.P. § 2143.01(V) describes, in part that “[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” Applicants submit the Office, in attempting to combine Katsuma and Osborne, in addition to not considering Katsuma as a whole, *supra*, is rendering Katsuma unsatisfactory for its intended purpose.

Katsuma is drawn to “[a] medicinal composition for external use of O/W type which comprises (a) physiologically active substance wholly or partially soluble in aqueous ethanol,

(b) a monoterpene difficultly soluble in aqueous ethanol or a mixture thereof with a monoterpene soluble in aqueous ethanol, (c) a non-ionic surfactant, and (d) aqueous ethanol” (emphasis added, see the Abstract of Katsuma). In describing his composition, Katsuma states “the invention provides a highly safe, precutaneously absorbable preparation which can allow desirable skin penetration of a medicine and does not irritate the skin (emphasis added, see the Abstract of Katsuma).

Further emphasizing these points, under Disclosure of the Invention, Katsuma, at page 2, lines 53-58, describes “it was found quite unexpectedly that the transdermal drug absorption-enhancing property of terpenes can be improved markedly without causing irritation to the skin, when ethanol, which is generally considered to be a solvent that spoils the transdermal absorption-enhancing property by dissolving oil of the emulsion and therefore destroying the emulsion, simultaneously showing irritation to the skin, is added at a specified ratio of the water content in the presence of a specified non-ionic surface active agent, hence resulting in the accomplishment of the present invention” (emphasis added).

Katsuma, at page 3, lines 49-52, describes that the “transdermal absorption preparation of the present invention is characterized in that the aforementioned terpenes are emulsified in aqueous ethanol, wherein the ethanol contained in the outer water layer is an essential composing element for sufficiently generating the absorption-enhancing effect of the aforementioned terpenes” (emphasis added).

Thus, Katsuma’s composition must contain ethanol, and Katsuma’s ethanol containing composition does not irritate the skin.

The Office, at page 6 of the Official Action, acknowledges that “Katsuma et al. teach the transdermal absorption preparation containing ethanol as a solvent, whereas the instantly claimed external preparation recites that the preparation does not contain ethanol.”

However, the Office then goes on to rely on Osborne to provide “a bio-adhesive formulation, i.e., pharmaceutical gel formulation or dermatological formulation that are capable of delivering drugs of varying solubility characteristics, wherein the formulation are suitable for applying to a skin surface....[because] from a practical point-of-view, increased water content is desirable...[because]...formulations containing non-aqueous solvents such as ethanol may give rise to this problem [i.e., irritating the skin] because ethanol is a drying agent” (see pages 6-7 of the Official Action).

Having reasoned as described *supra*, the Office then concludes, as a basis for combining Katsuma and Osborne, that “one of ordinary skill in the art would have been motivated to avoid the use of ethanol [in the formulation of Katsuma, so motivated by Osborne] ...because it is known in the art that ethanol is a dehydrating agent and may give undesirable effect to the skin.”

The Office’s reasoning suffers from multiple defects.

As described, *supra*, the Office must consider Katsuma as a whole, and Katsuma, taken as a whole, teaches that ethanol is a necessary component of Katsuma’s composition and that Katsuma’s composition does not irritate the skin. Thus the Office, in removing ethanol from Katsuma’s composition, is not considering Katsuma as a whole as required by M.P.E.P. § 2141.02(VI).

Further, because Katsuma requires the presence of ethanol, and the composition of present Claim 1 does not contain ethanol, Katsuma “teaches away from” at least one feature of present Claim 1 and the claims depending therefrom. The Office, in making the obviousness rejection, has ignored the secondary consideration of “teaching away from.” Applicants note that of all the secondary considerations, “teaching away from” has been continuously found, by the Supreme Court, to support patentability in a line of cases ranging

from United States v. Adams, 383 U.S. 39, 51-52, 148 USPQ 479, 483-84 (1966) through KSR v. Teleflex, 550 U.S. 398 (2007).

Moreover, as described *supra*, Katsuma's composition depends upon the presence of ethanol for its effectiveness in delivering active substances: “the transdermal drug absorption-enhancing property of terpenes can be improved markedly without causing irritation to the skin,...when ethanol is added at a specified ratio of the water content.” Thus, removing ethanol from Katsuma's composition, as the Office is attempting to do, would render Katsuma inoperable for its intended purpose, and this is impermissible under M.P.E.P. § 2143.01(V).

Finally, Applicants submit the Office has not provided sufficient motivation to combine the references. As described *supra*, Katsuma, multiple times, teaches his ethanol containing composition does not irritate the skin. Nevertheless, the Office has ignored Katsuma's teachings and reasoned, as a rationale for combining Katsuma with Osborne, that one of ordinary skill in the art would want to avoid the use of ethanol because of its “dehydrating and undesirable [that is, irritating] effects on the skin.” Thus, the Office has fabricated a problem that Katsuma explicitly states does not exist for Katsuma's formulation, and then used the fabricated problem as a rationale for combining the references. This logic is clearly flawed and is not a rationale to combine the references.

Withdrawal of the obviousness rejection is requested.

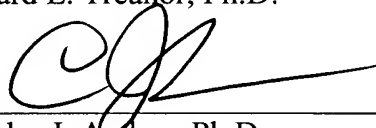
The obviousness rejection of Claims 21-22 and 26-27 as being unpatentable in view of Katsuma, Osborne, Sawayanagi and Hidaka is traversed. Claims 21-22 and 26-27 depend, either directly or indirectly, from Claim 1. As described *supra*, the combination of Katsuma and Osborne is improper because the Office has failed to consider Katsuma as a whole; because there is no motivation to combine the references; because Katsuma “teaches away

from” at least one feature of present Claim 1 and the claims depending therefrom; and because the Office’s combination of the references impermissibly renders Katsuma inoperable for its intended purpose. Sawayanagi, whom the Office relies upon to teach a “plaster preparation” (see page 11 of the Official Action), and Hidaka, whom the Office relies upon to teach a “pharmaceutical plaster” (see page 12 of the Official Action), do not remedy the deficiencies of Katsuma and Osborne. Withdrawal of the obviousness rejection is requested.

Applicants submit the present application is now in condition for allowance. Early notification to this effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Richard L. Treanor, Ph.D.



Charles J. Andres, Ph.D.
Attorney of Record
Registration No. 57,537

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)